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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,951	09/05/2000	Lester Andrew Evans	RJENK14.001A	8225

20995 7590 05/21/2004

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2645

18

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,951

Applicant(s)

EVANS ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-37 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-31, 35-37 and 42 is/are rejected.
- 7) ☒ Claim(s) 32-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. **Claims 38-41 and 43-44** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 17 therefore the restriction is final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 23-27, 35 and 42** are rejected under 35 U.S.C. 102(e) as being anticipated by Venturini (US 5,987,317).

Regarding **claim 23**, Venturini discloses a method of providing a mailbox answerphone service (column 4, line 50 “messages”) to a caller (column 4, line 51 “users”) in a mobile communications system (34a on FIG. 2) during a call (column 7, line 14 “PBX responds”) directed to a directory number used commonly by different

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subscribers to access their mailboxes (column 1, lines 6-8), (which reads on “an automatic public/ autonomous system message indicator recognition”), comprising:

providing an identification code (column 8, line 29 “the access code”) identifying a mailbox (column 8, line 34 “mailbox”) associated with a subscriber (column 8, line 46 “user”) through an answerphone service (column 8, lines 29-48) [The mobile terminal 10 user dials the access code with a request to retrieve the voice messages from the voice mailbox]; and

entering either a first mode of answerphone operation (column 8, line 52 “for a case the message is transmitted to the public network”) or a second, different, mode of answerphone operation in dependence on information received during call establishment indicating whether the call is of international origin (column 8, lines 29-48) [The mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal, the examiner considers this case as the national mode, since the limitation is either national mode or international mode].

Regarding **claim 24**, Venturini discloses in the first mode of operation, if the call is not diverted, providing a message retrieval service, and if the call is diverted, providing a message deposit service (column 7, lines 12-23).

Regarding **claim 25**, Venturini discloses determining whether the call is diverted using information received during call establishment (column 7, lines 24-35).

Regarding **claim 26**, Venturini discloses providing in the second mode of operation either a message deposit service or a message retrieve service in dependence of a receipt of a selection indicator from the caller during the call (column 7, lines 36-41).

Regarding **claim 27**, Venturini discloses in the second mode prompting the caller, after inputting the identification code during the call, for a voice message to be received and stored, and providing the message retrieve service if the indicator is received from the user (column 8, lines 29-48).

Regarding **claim 35**, Venturini discloses a method of providing a mailbox answerphone service (column 4, line 50 "messages") to a caller (column 4, line 51 "users") in a mobile communications system (34a on FIG. 2) during a call (column 7, line 14 "PBX responds) directed to a directory number used commonly by different subscribers to access their mailboxes (column 1, lines 6-8), (which reads on "an automatic public/ autonomous system message indicator recognition"), comprising:

identifying, through an answerphone service (column 8, line 30 "the network"), a mailbox (column 8, line 34 "mailbox") associated with a subscriber identification code (column 8, lines 29-48) [The mobile terminal 10 user dials the access code with a request to retrieve the voice messages from the voice mailbox]; and

automatically entering either a first mode of answerphone operation (column 8, line 52 "for a case the message is transmitted to the public network") if the call is of

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national original (column 8, lines 60-61 "the network with which the mobile terminal is registered") or a second, different mode of answerphone operation if the call is of international origin (column 8, lines 29-48) [The mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal, the examiner considers this case as the national mode, since the limitation is either national mode or international mode].

Regarding **claim 42**, Venturini discloses a voice processing system for a mobile communications system (column 1, lines 6-8) (which reads on "an automatic public/ autonomous system message indicator recognition"),

adapted to identify a mailbox (column 8, line 34 "mailbox") associated with a subscriber (column 8, line 46 "user") by way of an identification code (column 8, line 29 "the access code") processed through an answerphone service (column 8, lines 29-48) [The mobile terminal 10 user dials the access code with a request to retrieve the voice messages from the voice mailbox],

to enter either a first mode of answerphone operation (column 8, line 52 "for a case the message is transmitted to the public network") or a second, different, mode of answerphone operation in dependence on information received during call establishment indicating whether the call is of international origin (column 8, lines 29-48) [The mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal, the examiner considers this case as the national mode, since the limitation is either national mode or international mode].

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claim 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Venturini in view of Hulen et al. (US 5,497,373).

Regarding **claim 28**, Venturini and Wilson as applied to **claim 26** differ from **claim 28**, in that it fails to disclose the indicator comprises a DTMF tone.

However, Hulen teaches the indicator comprises a DTMF tone (column 7, lines 37-40).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the indicator comprises a DTMF tone of Hulen in the invention of Venturini.

The modification of the invention would offer the capability of the indicator comprises a DTMF tone such as the equipment user would define their own service application.

7. **Claims 29 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Venturini in view of Wilson and in further view of Kennedy, III et al. (US 5,539,810).

Regarding **claim 29**, Venturini and Wilson as applied to **claim 23** above differ from **claim 29** in that it fails to disclose prompting the caller for the identification code.

However, Kennedy teaches prompting the caller for the identification code if the identification code is otherwise not associated with the call when received (column 11, lines 33-38).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use prompting the caller for the identification code of Kennedy in the invention of Venturini.

Doing so would request an identification code.

Regarding **claim 30**, Kennedy teaches wherein the identification code corresponds to a directory number of the subscriber (column 11, lines 17-19).

8. **Claims 31, 36 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Venturini in view of Wilson et al. (US 5,838,772).

Regarding **claim 31** Venturini as applied to claim 23 differ from claim 31 in that it fails to disclose identifying a call of international origin through an international origin indicator in signaling associated with the call.

However, Wilson teaches identifying a call of international origin through an international origin indicator in signaling associated with the call (column 7, lines 44-51).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Venturini use prompting the caller for the identification code as taught by Kennedy.

Doing so the system would request an identification code so that the user would access its mailbox.

Regarding **claim 36**, Wilson teaches deriving the origin of the call using information received during call establishment (column 8, lines 31-38).

Regarding **claim 37**, Wilson teaches using the common directory number by all subscribers to access the answerphone service (column 7, lines 44-46).

Allowable Subject Matter

9. **Claims 32-34** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter.

The prior art of record at this time fails to disclose setting the divert flag if the call is diverted from a mobile station to the apparatus and the mobile station is located within a coverage area of the mobile communications system, associating the CLI signal with the call if the call originates or is diverted from a mobile station within the coverage area and the mobile station is preset to transmit the CLI signal and associating the international origin indicator with the call if the call originates or is diverted from a mobile station and the mobile station is used at a location causing the international origin indicator to be sent to the mobile communications system during call establishment.

Response to Arguments

11. Applicant's arguments with respect to **claims 23-31, 35-37 and 42** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Williams et al. is cited for a method of providing wireless local loop operation with local mobility for a subscribed unit.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


g.g.
May 16, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

